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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,415	01/02/2001	Jonathan Strietzel	034328.0003.CIP1	1865
7590	06/16/2004		EXAMINER	RAMOS FELICIANO, ELISEO
NOEL C. GIESPIE BROBECK, PHLEGER & HARRISON, LLLP 12390 EL CAMINO REAL SAN DIEGO, CA 92130			ART UNIT	PAPER NUMBER
			2681	8
DATE MAILED: 06/16/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

JUN 25 2004

Technology Center 2600

Office Action Summary	Application No.	Applicant(s)	
	09/753,415	STRIETZEL, JONATHAN	
	Examiner Eliseo Ramos-Feliciano	Art Unit 2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 March 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	6) <input type="checkbox"/> Other: _____.

DETAILED ACTION***Claim Objections***

1. **Claim 1** is objected to because of the following informalities: the claim as amended introduces what appears to be a typographical error; line 8 of the amended claim, recites “an advertisement, database” (note the use of a comma “,”) while it should be -- an advertisement database-- (without the comma) to be consistent with the claim language as originally presented. Correction is required.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statement filed on April 5, 2004 have been considered by the examiner (see attached PTO-1449 form).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1 and 26-33** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary (US Patent Number 5,852,775) in view of Gregorek et al. (US Patent Number 5,557,658).

Regarding **claim 1**, Hidary discloses a wireless communication system (Figure 1), comprising: a radio interface (Fig. 1); a plurality of terminals configured to play advertisements and to communicate voice and data over the radio interface (16 and 16a subscriber, 28 non subscriber in Fig. 1); at least one network node configured to communicate with the plurality of terminals over the radio interface (column 4, lines 57-60; “central station”), the network node

including: a fixed network interface (column 4, lines 66-67); a telecommunications advertising means (column 1, lines 6-8) comprising an advertisement database (Elements 60, 62, 66 and/or Memory bank 26 in Fig. 2; 26 in Fig. 1) and a processing means coupled with the advertisement database (Ad server 24 coupled through microprocessor 50 and data bus 56 to the elements 60, 62 and 66 of memory bank 26 in Fig 2), the processing means configured to selectively associate at least one advertisement in the advertisement database with an incoming communication (column 3, lines 24-25); and a switching center coupled to the telecommunications advertising means (MTSO 12 coupled to AD server 24 in Fig 1), the switching center configured to route communications between the terminals (column 1, lines 44-50), to route communications from the terminals to fixed network users via the fixed network interface (column 1, lines 49-50), to route advertisements associated with a source of the incoming communication by the telecommunications advertising means to a terminal associated with the source (column 1, lines 57-65; column 3, lines 30-54), and to route advertisements associated with a destination of the incoming communication by the telecommunications advertising means to a terminal associated with the destination (column 4, line 13-25).

However, Hidary fails to specifically disclose to route the advertisements in place of ring tones of a ringback signal as defined by applicant in the claim.

In the same field of endeavor, i.e. marketing or advertising, Gregorek et al. discloses a communication system (Figure 1) that includes a switching center (15, 21; Figure 1) configured to route advertisements (announcements) in place of ring tones of a ringback signal (column 2, lines 11-30, 63-67; column 16, lines 17-21, 38-43). The same Gregorek et al. teaches that it

would be advantageous to replace the ringback signal by advertisements because the advertisements would provide the users with useful information (column 2, lines 11-16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to route advertisements in place of ring tones of Hidary's ringback signal because the advertisements would provide the users with useful information as taught by Gregorek et al.

Regarding **claim 26**, see the rejection of *claim 1* regarding the subject matter this claim is dependant upon. Hidary discloses that the messages have a duration "of about 1-30 seconds" which is contended to be approximately the same duration as a ring tone normally included in the ringback signal (column 1, line 59).

Regarding **claim 27**, see the rejection of *claim 26* regarding the subject matter this claim is dependant upon. Gregorek et al. discloses to replace a ringback signal by one or more advertisements (column 2, lines 63-66); because this would provide the calling party with useful information (column 2, lines 15-17).

Regarding **claim 28**, see the rejection of *claim 26* regarding the subject matter this claim is dependant upon. Gregorek et al. discloses that the advertisements can be, for example, audio, video, graphic or combination thereof (column 2, lines 14, 26); because this would provide the calling party with useful information (column 2, lines 15-17) without annoying the calling party (column 1, line 67).

Regarding **claim 29**, Hidary discloses a method of advertising over a telecommunication network (Figure 1), including: storing a plurality of advertisements in a database coupled to the telecommunication network (Elements 60, 62, 66 and/or Memory bank 26 in Fig. 2; 26 in Fig. 1;

column 1, lines 6-8); selecting an advertisement from the database based on an incoming signal received from a telecommunications medium (column 1, lines 61-65; column 3, lines 39-50); and transmitting the advertisement to the telecommunication medium (column 3, lines 39-41).

However, Hidary fails to specifically disclose replacing, in a ringback signal, a tone played to the telecommunication medium by the network with the selected advertisement as defined by applicant in the claim.

In the same field of endeavor, i.e. marketing or advertising, Gregorek et al. discloses a method of advertising over a communication network (Figure 1), including the step of replacing advertisements (announcements) in place of ring tones of a ringback signal (column 2, lines 11-30, 63-67; column 16, lines 17-21, 38-43). The same Gregorek et al. teaches that it would be advantageous to replace the ringback signal by advertisements because the advertisements would provide the users with useful information (column 2, lines 11-16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to route advertisements in place of ring tones of Hidary's ringback signal because the advertisements would provide the users with useful information as taught by Gregorek et al.

Regarding **claim 30**, see the rejection of *claim 29* regarding the subject matter this claim is dependant upon. Hidary discloses that the continued playing of the advertisement indicates to the telecommunications medium that a called party has not answered (column 2, lines 11-21, 63-67 and column 3, lines 1-16).

Regarding **claim 31**, see the rejection of *claim 29* regarding the subject matter this claim is dependant upon. Gregorek et al. discloses that the advertisements can be, for example, audio,

video, graphic or combination thereof (column 2, lines 14, 26); because this would provide the calling party with useful information (column 2, lines 15-17) without annoying the calling party (column 1, line 67).

Regarding **claim 32**, see the rejection of *claim 29* regarding the subject matter this claim is dependant upon. Hidary teaches the further steps of: analyzing the incoming signal to identify the telecommunication medium that transmitted the signal (column 1, lines 61-65; column 3, lines 4-7); obtaining information about the identified telecommunication medium (column 3, lines 39-41); and selectively associating the advertisement to be transmitted to the telecommunication medium based on the obtained information (column 3, lines 42-50).

Regarding **claim 33**, see the rejection of *claim 29* regarding the subject matter this claim is dependant upon. Gregorek et al. discloses to replace a ringback signal by one or more advertisements (column 2, lines 63-66); because this would provide the calling party with useful information (column 2, lines 15-17).

5. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary and Gregorek et al. as applied to *claim 1* above, and further in view of Farris et al. (US Patent Number 6,151,491).

Regarding **claim 3**, see the rejection of *claim 1* regarding the subject matter this claim is dependant upon. Hidary and Gregorek et al. do not disclose that some or all of the terminals are configured to forward advertisements received by the terminals to other terminals within the wireless communication system. However, Farris discloses: "The user is then presented with the option of sending and/or forwarding and/or broadcasting the received messages in Step T40. The mobile then determines whether the user has indicated that the message is to be forwarded and/or

broadcast and/or sent in Step T42. The mobile then determines whether the user has indicated that the message is to be forwarded and/or broadcast and/or sent in Step T42" (column 32, lines, 24-29). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to apply the above teachings of Farris to Hidary and Gregorek et al. in order to forward the advertisements to other terminals owned by friends or family that may be interested in the advertised products.

6. **Claims 4 and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary and Gregorek et al. as applied to *claim 1* above, and further in view of Owensby (US Patent Application Publication Number US-2002/0077130-A1).

Regarding **claim 4**, see the rejection of *claim 1* regarding the subject matter this claim is dependant upon. Hidary and Gregorek et al. do not disclose that some or all of the terminals are configured to optionally connect, through the switching center to the source of any advertisement routed to the terminal by the switching center. However, Owensby discloses "the subscribers of a wireless mobile communications service to interactively request and receive additional information relating to messages provided to the subscriber and to be connected to a telemarketing representative, or to respond to inquiries from the operator of the service or the sponsor of the message" (lines1-7 of paragraph 37). Furthermore see Figure 1, for making the connection through the switching center. Therefore, at the time of the invention it could have been obvious to a person of ordinary skill in the art to add this feature in Owensby to Hidary and Gregorek et al.'s invention, so that the user may contact and obtain information about the store from personnel at the store or make purchases.

Regarding **claim 9**, see the rejection of *claim 4* regarding the subject matter this claim is dependant upon. Hidary and Gregorek et al. do not disclose that the wireless communication system is further configured to allow the source and/or destination of the incoming communication to be connected to the source of an advertisement prior to completion of the incoming communication. However, Owensby discloses, "insertion of an advertisement only prior to connection of the call or also at regular intervals during the call" (lines 16-18 of paragraph 63). Note intervals during call include the time prior to completion of the call. Furthermore, lines 1-7 of paragraph 37 states "Yet another object of the invention is to permit subscribers of a wireless mobile communications service to interactively request and receive additional information relation to messages provided to the subscribers and to be connected to a telemarketing representative, or to respond to inquires from the operator of the service other sponsor of the message". Therefore, at the time of the invention it could have been obvious to a person of ordinary skill in the art to add this feature as taught by Owensby to Hidary and Gregorek et al.'s invention, to facilitate communications between the subscriber and the advertising sponsor.

7. **Claims 5-7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary, Gregorek et al., and Owensby as applied to *claim 4* above, and further in view of Ogasawara (US Patent Number 6,512,919).

Regarding **claim 5**, see the rejection of *claim 4* regarding the subject matter this claim is dependant upon. The combination of Hidary, Gregorek et al., and Owensby do not disclose that some or all of the terminals are configured to navigate through information provided by the source of the advertisement once the terminal is connected to the source of the advertisement.

However, Ogasawara does disclose the limitation above (column 9, lines 19-23 and lines 34-37). Therefore, at the time of the invention it could have been obvious to a person of ordinary skill in the art to add navigational features in Ogasawara to the system of Hidary, Gregorek et al., and Owensby, in order to enable the subscriber to choose from different options a source of advertisement is offering.

Regarding **claim 6**, see the rejection of *claim 4* regarding the subject matter this claim is dependant upon. The combination of Hidary, Gregorek et al., and Owensby fails to disclose that some or all of the terminals are configured to facilitate purchasing of products or services once the terminal is connected to the source of the advertisement. However, Ogasawara discloses, "The electronic shopping section 29 comprises some of those components of the present invention which are added to a contemporary wireless telephone so as to facilitate electronic shopping" (column 8, lines 18-20). Further discloses, "Alternatively, the purchaser might manually enter a credit card account number, expiration date and the like, into the wireless videophone using the keypad" (column 21, lines 51-53). Therefore, at the time of the invention it could have been obvious to a person of ordinary skill in the art to add this feature in Owensby to Hidary, Gregorek et al., and Owensby, in order to facilitate the purchasing of products.

Regarding **claim 7**, see the rejection of *claim 6* regarding the subject matter this claim is dependant upon. The combination of Hidary, Gregorek et al., and Owensby fails to disclose that some or all of the terminals are configured to allow charge account information to be input into the terminal, and wherein the terminal provides the charge account information to the source of the advertisement to facilitate the purchasing of products or services. However, Ogasawara discloses, "The wireless telephone 18 comprises a microprocessor 38 in communication with

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wireless telephone function electronics 40, display 42, keypad 44, input/output port 36, and IC card reader/writer 27. The microprocessor 38, wireless telephone function electronics 40, display 42, keypad 44, input/output port 36, and IC-card reader/writer 27 are all typical components of a contemporary wireless telephone" (column 7, lines 48-54). Furthermore, he discloses, "The IC card reader/writer 27 is used to read and write to an integrated circuit (IC) card which contains user account information and may be used with a plurality of different compatible wireless telephones, generally so as to facilitate billing to a desired customer" (column 8, lines 10-14). Therefore, at the time of the invention it could have been obvious to a person of ordinary skill in the art to add this feature in Ogasawara to the system of Hidary, Gregorek et al., and Owensby, to provide charge account information to the source for billing purposes in order to facilitate the purchasing of products.

8. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary, Gregorek et al., Owensby, and Ogasawara as applied to *claim 6* above, and further in view of Baker (US Patent Number 6,505,046).

Regarding **claim 8**, see the rejection of *claim 6* regarding the subject matter this claim is dependant upon. The combination of Hidary, Gregorek et al., Owensby, and Ogasawara do not disclose that the telecommunication advertising means stores charge account information associated with each terminal, and wherein the telecommunications advertising means automatically supplies the charge account information to the source of the advertisement to facilitate purchasing of products or services. However, Baker does disclose the limitation above (column 2, line 66 to column 3, line 6). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art the modify of subscriber profile data base of

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Hidary, Gregorek et al., Owensby, and Ogasawara's invention with the above teachings of Baker to also store charge account information, in order to facilitate purchasing by the subscribers without having to re-enter charge account information.

9. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary, Gregorek et al., and Owensby as applied to *claim 4* above, and further in view of Farris et al. (US Patent Number 6,151,491).

Regarding **claim 10**, see the rejection of *claim 4* regarding the subject matter this claim is dependant upon. The above Hidary, Gregorek et al., and Owensby do not disclose that some or all of the terminals are configured to store a list of advertisements played during the completion of the incoming communication. However, Farris et al. discloses, "Thus, the present invention is not only able to store completely the data, voice mail and/or electronic mail messages on the handset, but is able to optionally supplement the messages received and forward the message and/or supplemental message to another destination" (column 34, lines 42-46). Therefore, at the time of the invention it could have been obvious to a person of ordinary skill in the art to modify the system of Hidary, Gregorek et al., and Owensby with the above teachings of Farris to store the advertising messages, in order to more conveniently retrieve them without having to connect to the wireless network.

10. **Claim 11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary, Gregorek et al., Owensby, and Farris et al. as applied to *claim 10* above, and further in view of Baker (US Patent 6,505,046).

Regarding **claim 11**, see the rejection of *claim 10* regarding the subject matter this claim is dependant upon. The combination of Hidary, Gregorek et al., Owensby, and Farris et al. do not

disclose that some or all of the terminals are configured to connect to the source of an advertisement selected from the list of advertisements after the completion of the incoming communication. However, Baker discloses, " The outlet telephone number field is from the retail outlet record and can be turned off and on by the retailer. This field is intended to enable the subscriber to dial that store on the spot. In a two-way messaging system, the message can include an optional reply ..." (column 4, lines 45-50). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the invention of Hidary, Gregorek et al., Owensby, and Farris et al., with the above teachings of Baker to allow the subscriber to call a selected advertising entity stored in its terminal, in order to facilitate communications between the subscriber and the advertising entity.

11. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary, Gregorek et al., and Owensby as applied to *claim 4* above, and further in view of Dowling et al. (US Patent Number 6,522,875).

Regarding **claim 12**, see the rejection of *claim 4* regarding the subject matter this claim is dependant upon. The combination of Hidary, Gregorek et al., and Owensby do not disclose the wireless communication system further comprising a packet data server configured to interface the plurality of terminals to the Internet, and wherein some or all of the terminals are configured to optionally connect, through the packet data server, to the source of any advertisement routed to the terminal. However, Dowling et al. discloses packet data server (Server 120, Figure 1, see also column 6, lines 12-15) configured to interface the plurality of terminals (Figure 1, mobile unit 105) to the Internet, (Figure 1, Internet 122) and wherein some or all of the terminals are configured to optionally connect, through the packet data server, to the source of any

advertisement routed to the terminal (column 23, lines 57-63). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the system of Hidary, Gregorek et al., and Owensby with the above teachings of Dowling, in order to provide packet data advertisements in addition to voice advertisements.

12. **Claims 13-14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary and Gregorek et al. as applied to *claim 1* above, and further in view of Ogawa et al. (US Patent Number 4,868,865).

Regarding **claim 13**, see the rejection of *claim 1* regarding the subject matter this claim is dependant upon. Hidary and Gregorek et al. do not disclose that the advertisements routed to the source of the incoming communication are played during at least one of the following points: prior to a ring back signal being applied to the source of the incoming communication; in place of ring tones associated with the ring back signal; in place of the ring back signal, and after the ring back signal, but before the source of the incoming communication is connected. However, Ogawa et al. discloses, "For instance, an RBT generator may be provided to send a pseudo ring back tone or the pseudo ring back tone may be replaced with another type of tone signal or a voice message that indicates the call being made" (column 10, lines 55-60). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the system of Hidary and Gregorek et al. with the teachings of Ogawa, in order to further increase advertising opportunities when a communications are made between two terminals.

Regarding **claim 14**, see the rejection of *claim 13* regarding the subject matter this claim is dependant upon. Hidary discloses advertisements routed to the destination of the incoming communication (column 4, line 13-25) are played prior to the source of the incoming

communication being connected with the destination of the incoming communication (column 1, line 57-59).

13. **Claims 15-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary and Gregorek et al. as applied to *claim 1* above, and further in view of Hymel et al. (US Patent Number 6,157,814).

Regarding **claim 15**, see the rejection of *claim 1* regarding the subject matter this claim is dependant upon. Hidary and Gregorek et al. do not disclose that at least a portion of the advertisement database is stored in each terminal in the plurality of terminals, and wherein the switching center routes a command provided by the telecommunications advertising means to the terminals indicating which advertisement to play. However, Hymel et al. teaches "the wireless subscriber unit 30 includes an advertisement memory 50 that stores a plurality of advertisement icons 52" (column 3, lines 16-18). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to add this feature as taught by Hymel et al., to Hidary and Gregorek et al.'s invention, in order to allow subscribers to access the advertisement without having to connect the wireless network.

Regarding **claim 16**, see the rejection of *claim 15* regarding the subject matter this claim is dependant upon. Hidary and Gregorek et al. do not disclose that the portion of the advertisement database stored in the terminals is updated by the telecommunications advertising means over the radio interface. However, Hymel et al. teaches, "The advertisement icons 52 in the advertisement memory 50, may be updated by the service provider sending update messages to the wireless subscriber unit 30, the message processor 36, upon receipt of an update message, will send a command to the advertisement manager 56 with the new advertisement icon data.

The advertisement manager 56 then stores this new advertisement icon 54 into the advertisement memory 50 for later use" (column 4, lines 4-11). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to add this feature as taught by Hymel et al., to the invention of Hidary and Gregorek et al., to update the advertisements any time the source of the advertisement wants to for example change promotional offers or offer new coupons.

14. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary (US Patent Number 5,852,775) in view of Gregorek et al. (US Patent Number 5,557,658), and further in view of Dowling et al. (US Patent Number 6,522,875).

Regarding **claim 17**, Hidary discloses a wireless communication system (Figure 1) including a communications carrier (column 1, line 25), a plurality of terminals (16, 16a, etc.) configured to communicate signals over the communications carrier, a telecommunications advertising means (column 1, lines 6-8) comprising an advertisement database (Elements 60, 62, 66 and/or Memory bank 26 in Fig. 2; 26 in Fig. 1) and a processing means coupled with the advertisement database (Ad server 24 coupled through microprocessor 50 and data bus 56 to the elements 60, 62 and 66 of memory bank 26 in Fig 2), the processing means configured to selectively associate at least one advertisement in the advertisement database with an incoming communication (column 3, lines 24-25); and to route advertisements associated with a source of the incoming communication by the telecommunications advertising means to a terminal associated with the source (column 1, lines 57-65; column 3, lines 30-54), and to route advertisements associated with a destination of the incoming communication by the

telecommunications advertising means to a terminal associated with the destination (column 4, line 13-25).

However, Hidary fails to specifically disclose to route the advertisements in place of ring tones of a ringback signal as defined by applicant in the claim.

Hidary further fails to specifically disclose that the communications carrier is a packet data carrier; that the plurality of terminals communicate packet data over the packet data carrier; nor that the incoming communication is packet data.

In the same field of endeavor, i.e. marketing or advertising, Gregorek et al. discloses a communication system (Figure 1) that includes a switching center (15, 21; Figure 1) configured to route advertisements (announcements) in place of ring tones of a ringback signal (column 2, lines 11-30, 63-67; column 16, lines 17-21, 38-43). The same Gregorek et al. teaches that it would be advantageous to replace the ringback signal by advertisements because the advertisements would provide the users with useful information (column 2, lines 11-16). In addition, Gregorek et al.'s switching center incorporates a packet switch (column 7, lines 15-24), which implies a packet data carrier; and the communication terminals are data calling terminals (column 17, lines 59-61) configured to communicate packet data over the packet data network.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to route advertisements in place of ring tones of Hidary's ringback signal because the advertisements would provide the users with useful information as taught by Gregorek et al.

Also, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include packet data as claimed, in order to maximize the capability of the advertising system by way of including packet data communications as taught by Gregorek et al.

On the other hand, Hidary fails to specifically disclose to interface the terminals with the Internet, nor to route communications between the terminals and the Internet over the packet data carrier.

Dowling et al. discloses a packet data carrier (Figure 1, see also column 6, lines 1-4); a plurality of terminals (Figure 1, Mobile Unit 105) configured to communicate packet data over the packet data carrier (column 6, lines 25-34); a packet data server (Server 120, Figure 1, see also column 6, lines 12-15, also column 8 lines 8-16) configured to interface the terminals with the Internet (Figure 1, Internet 122), to route communications between the terminals and the Internet over the packet data carrier (column 6, lines 16-17).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply Dowling et al.'s teachings to modify Hidary and Gregorek et al.'s invention to include packet data communication with the Internet as claimed, in order to maximize the capability of the advertising system by way of expanding the range of communications to the World Wide Web as Dowling et al. teaches.

15. **Claim 18** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary, Gregorek et al., and Dowling et al. as applied to *claim 17* above, and further in view of Owensby (US Patent Application Publication Number US-2002/0077130-A1).

Regarding **claim 18**, see the rejection of *claim 17* regarding the subject matter this claim is dependant upon. However, Hidary, Gregorek et al., and Dowling et al. do not disclose some or

all of the terminals are configured to optionally connect, through the packet data server to the source of any advertisement routed to the terminal by the packet data server. However, Owensby discloses terminals are configured to optionally connect (paragraph 37, lines 1-7), through the packet data server to the source of any advertisement routed to the terminal by the packet data server (although Figure 1 does not explicitly show the packet data server it is inherent that the communications take place through a packet data server since Figure 1 is a C/PCS network, see also lines 1-6 of paragraph 3). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to add the teachings of Owensby to Hidary, Gregorek et al., and Dowling et al., so that the user may contact and obtain information about the store from personnel at the store or make purchases.

16. **Claims 19- 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary, Gregorek et al., Dowling et al., and Owensby as applied to *claim 18* above, and further in view of Ogasawara (US Patent Number 6,512,919).

Regarding **claim 19**, see the rejection of *claim 18* regarding the subject matter this claim is dependant upon. Hidary, Gregorek et al., Dowling et al., and Owensby do not disclose that some or all of the terminals are configured to navigate through information provided by the source of the advertisement once the terminal is connected to the source of the advertisement. However, Ogasawara does disclose the limitation above (column 9 lines 19-23 and lines 34-37). Therefore, at the time of the invention it could have been obvious to a person of ordinary skill in the art to add navigational features as taught by Ogasawara to the system of Hidary, Gregorek et al., Dowling et al., and Owensby, in order to enable the subscriber to use his terminal choose from different options a source of advertisement is offering.

Regarding **claim 20**, see the rejection of *claim 19* regarding the subject matter this claim is dependant upon. Hidary, Gregorek et al., Dowling et al., and Owensby do not disclose that some or all of the terminals are configured to facilitate purchasing of goods and services once the terminal is connected to the source of the advertisement. However, Ogasawara discloses the limitation above, "The electronic shopping section 29 comprises some of those components of the present invention which are added to a contemporary wireless telephone so as to facilitate electronic shopping" (column 8, lines 18-21). He further discloses, "Alternatively, the purchaser might manually enter a credit card account number, expiration date and the like, into the wireless videophone using the keypad" (column 21, lines 51-53). Therefore, at the time of the invention it could have been obvious to a person of ordinary skill in the art to add this feature as taught by Ogasawara to Hidary, Gregorek et al., Dowling et al., and Owensby, in order to expedite the purchasing of products.

Regarding **claim 21**, see the rejection of *claim 20* regarding the subject matter this claim is dependant upon. Hidary, Gregorek et al., Dowling et al., and Owensby do not disclose some or all of the terminals are configured to allow charge account information to be input into the terminal, and wherein the terminal provides the charge account information to the source of the advertisement to facilitate the purchasing of goods and services. However, Ogasawara discloses, "The wireless telephone 18 comprises a microprocessor 38 in communication with wireless telephone function electronics 40, display 42, keypad 44, input/output port 36, and IC card reader/writer 27. The microprocessor 38, wireless telephone function electronics 40, display 42, keypad 44, input/output port 36, and IC-card reader/writer 27 are all typical components of a contemporary wireless telephone" (column 7, lines 48-54). Furthermore, he discloses, "The IC-

card reader/writer 27 is used to read and write to an integrated circuit (IC) card which contains user account information and may be used with a plurality of different compatible wireless telephones, generally so as to facilitate billing to a desired customer" (column 8, lines 10-14). Therefore, at the time of the invention it could have been obvious to a person of ordinary skill in the art to add this feature as taught by Ogasawara to Hidary, Gregorek et al., Dowling et al., and Owensby, for the advantage of facilitating billing to a desired customer.

17. **Claim 22** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary, Gregorek et al., Dowling et al., Owensby, and Ogasawara as applied to *claim 20* above, and further in view of Baker (US Patent Number 6,505,046).

Regarding **claim 22**, see the rejection of *claim 20* regarding the subject matter this claim is dependant upon. Hidary, Gregorek et al., Dowling et al., Owensby, and Ogasawara do not disclose the telecommunication advertising means stores charge account information associated with each terminal, and wherein the telecommunications advertising means automatically supplies the charge account information to the source of the advertisement to facilitate purchasing of goods and services. However, Baker discloses the limitation above in column 2, line 66 to column 3, line 6. Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify the subscriber profile database of Hidary, Gregorek et al., Dowling et al., Owensby, and Ogasawara with the above teachings of Baker, to also store charge account information, in order to facilitate and expedite purchasing by the subscribers who would not have to re-enter charge account information when making a purchase.

18. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary (US Patent Number 5,852,775) in view of Gregorek et al. (US Patent Number 5,557,658), and further in view of Owensby (US Patent Application Publication Number US-2002/0077130-A1).

Regarding **claim 23**, Hidary discloses a method of telecommunications advertising in a wireless communication system configured for voice communication between a source and a destination (Figure 1), the method comprising: storing a plurality of advertisements (Elements 60, 62, 66 and/or Memory bank 26 in Fig. 2; 26 in Fig. 1); selectively associating one or more of said plurality of advertisements with a communication in the wireless communication system (column 3, lines 24-25 & 39-50); playing one or more advertisements through a terminal associated with the source or destination of the communication prior to connecting the source to the destination for purposes of completing the communication (column 1, lines 57-59; column 3, lines 30-37).

However, Hidary fails to specifically disclose to route the advertisements in place of ring tones of a ringback signal as defined by applicant in the claim.

In the same field of endeavor, i.e. marketing or advertising, Gregorek et al. discloses a communication system (Figure 1) that includes a switching center (15, 21; Figure 1) configured to route advertisements (announcements) in place of ring tones of a ringback signal (column 2, lines 11-30, 63-67; column 16, lines 17-21, 38-43). The same Gregorek et al. teaches that it would be advantageous to replace the ringback signal by advertisements because the advertisements would provide the users with useful information (column 2, lines 11-16).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to route advertisements in place of ring tones of Hidary's ringback signal

because the advertisements would provide the users with useful information as taught by Gregorek et al.

However, Hidary and Gregorek et al. fail to disclose connecting the terminal with a company associated with one of the one or more advertisements. Nevertheless, Owensby discloses this limitation in lines 1-7 of paragraph 37. Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to modify Hidary and Gregorek et al.'s invention with Owensby teaching to expand and enhance the services offered to the users.

19. **Claims 24-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hidary, Gregorek et al., and Owensby as applied to *claim 23* above, and further in view of Ogasawara (US Patent 6,512,919).

Regarding **claim 24**, see the rejection of *claim 23* regarding the subject matter this claim is dependant upon. The combination of Hidary, Gregorek et al., and Owensby fails to disclose permitting the terminal to browse information and/or products or services offered by the company. However, Ogasawara discloses the limitation above (column 9, lines 19-23 and lines 34-37). Therefore, at the time of the invention it could have been obvious to a person of ordinary skill in the art to add navigational features of Ogasawara to the system of Hidary, Gregorek et al., and Owensby, in order to enable the subscriber to choose from different options a source of advertisement is offering.

Regarding **claim 25**, see the rejection of *claim 24* regarding the subject matter this claim is dependant upon. The combination of Hidary, Gregorek et al., and Owensby fails to disclose permitting the terminal to purchase one or more products or services offered by the company. However, Ogasawara discloses, "Alternatively, the purchaser might manually enter a credit card

account number, expiration date and the like, into the wireless videophone using the keypad" (column 21, lines 51-53). Therefore, at the time of the invention it could have been obvious to a person of ordinary skill in the art to add this feature of Ogasawara to the system of Hidary, Gregorek et al., and Owensby in order to expedite the purchasing of products.

Response to Arguments

20. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments are repetitive and directed to the new (underlined) limitations. These limitations have now been treated on the merits; see rejection section above.

Citation of Pertinent Prior Art

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Go (US Patent Application Publication Number US-2002/0022476-A1) discloses an advertising system for cellular telephones;

Sleevi (US Patent Number RE.34,380) discloses applying messages in a telecommunications network.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

23. Any inquiry concerning this communication from the examiner should be directed to Eliseo Ramos-Feliciano whose telephone number is 703-305-0078. The examiner can normally be reached from 8:00 a.m. to 5:30 p.m. on 5-4/9 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A. Gary, can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ELISEO RAMOS-FELICIANO
PATENT EXAMINER

ERF/erf
June 10, 2004

Erika Gary
ERIKA GARY
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